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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,915

04/10/2006

Jean-Luc Clement

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EXAMINER

MERENE, JAN CHRISTOP L

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

02/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,915	Applicant(s) CLEMENT ET AL.	
	Examiner JAN CHRISTOPHER MERENE	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/22/2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "flexible structure" (Claims 5, 10-12) and "metal wire has spires" (Claims 6-7) must be shown (and/or clearly labeled) or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

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2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-14** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 13-14 recites "for running down connecting parts," where connecting parts has lack of preceding antecedent basis. For examining purposes, the examiner will treat "connecting part" as the part recited in claim 1, 13, 14. Regardless, the statement is unclear and indefinite since the extension piece rest on the threaded stud. The examiner will further treat this limitation as the part can engage the extension piece, where the part can "run down" along the extension piece and threaded stud and where the extension piece can engage a proximal zone of the bony anchoring member.

Claim 1 further recites "the proximal threaded stud of at least one anchoring member and the corresponding extension piece used with said bony anchoring member." It is unclear if the applicant is referring to another bone anchoring member or the same bone anchoring member. For examining purposes, the examiner will treat this limitation as the proximal stud of one bony anchor member, with an extension piece and a positioning member.

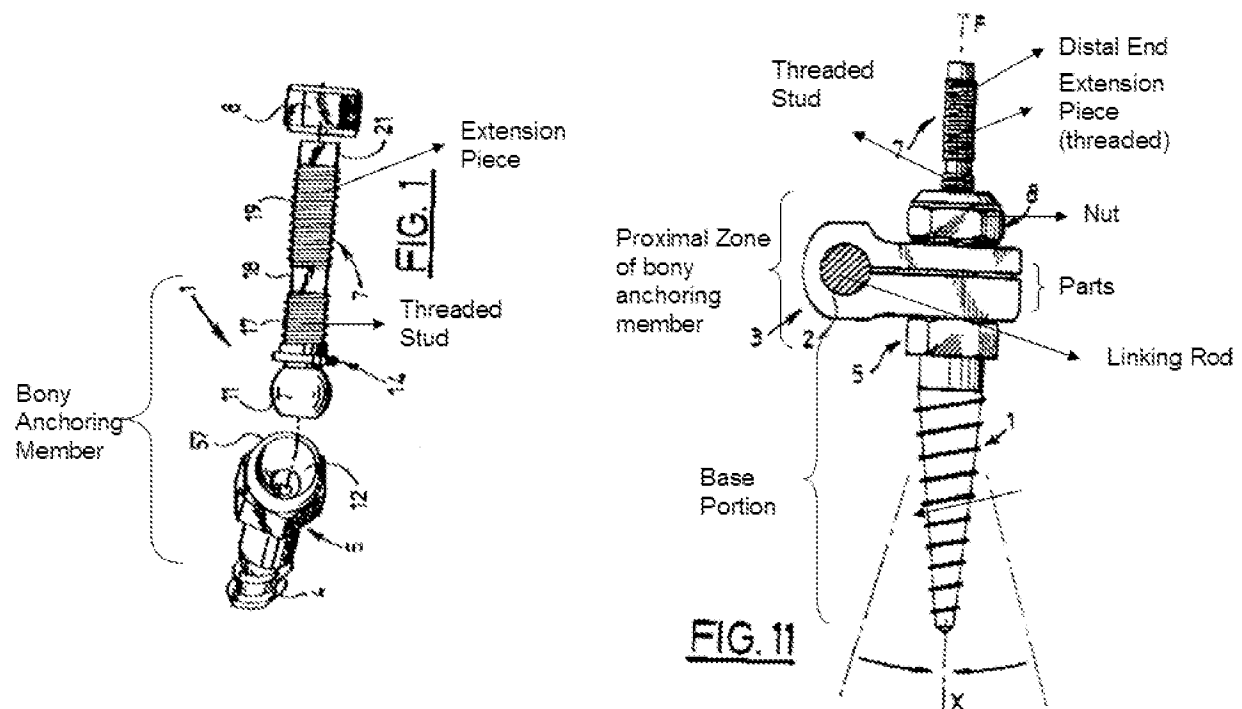
4. The claims continue to be generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

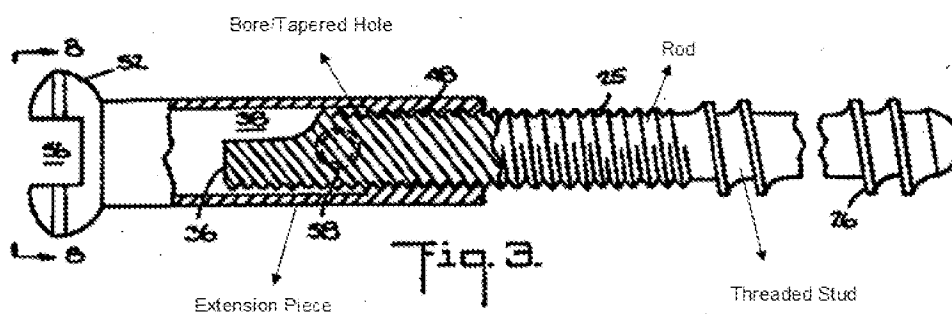
6. **Claims 1-4, 8, 9, 13-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al US 6,267,765 in view of Asnis et al US 5,217,462.

Regarding **Claims 1-4, 8-9, 13-14** Taylor discloses vertebral osteosynthesis equipment comprising a bony anchoring member with a threaded stud and a base portion, a linking rod, a part for connecting the linking rod to the bony anchoring member, a nut, where the nut has a diameter to go over the threaded stud, wherein an extension piece is attached to a proximal zone of the threaded stud and has a distal end that is threaded, which is also sized such that the nut can go over the extension piece (as seen in Fig below and see Col 5 lines 30-35, where the extension piece is removable from the threaded stud).



However, Taylor does not specifically disclose a positioning member for connecting where the extension piece and threaded stud, where the extension piece has a bore and the threaded stud has a threaded rod.

However, Asnis discloses a threaded stud, an extension piece (as seen in Fig below) and a positioning member, where the extension rod/ screw has a rod adapted to engage the tapered bore/hole of the extension (as seen in Fig below).



It would have been obvious to one having ordinary skill in the art to modify the threaded stud and extension piece of Taylor et al to have the rod and tapered hole/bore so that the threaded stud and extension piece are extendable, where both are axially connected, as taught by Asnis et al because the lengths of the screw can be modified as desired (see Col 3 lines 60-63). (The examiner further notes that with the combination of Taylor and Asnis, the nut would still be capable of going over the extension piece since the modification is towards the connection between the extension piece and threaded stud of Taylor to include the rod and bore/ tapered hole features as taught by Asnis).

7. **Claims 5-7, 10-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al US 6,267,765 and Asnis et al US 5,217,462 as applied to claims 1-4, above in further view of Beyar US 2002/0095181.

Taylor et al and Asnis et al disclose the claimed invention as discussed above where the extension piece has an external thread on the distal end portion but does not specifically disclose the thread is a flexible structure in the form of a metal wire wound into a spiral, where the wire has spirals that are contiguous.

However Beyar discloses various bone anchors with a flexible structure, with a wire wrapped around a bone anchor, where the spires of the wire are contiguous (see paragraph 112 and 114).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the flexible structure of Taylor et al and Asnis et al to include the flexible structure Beyer because it applies a known technique to known

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device to yield predictable results of forming threads on a screw (see paragraphs 112 and 114).

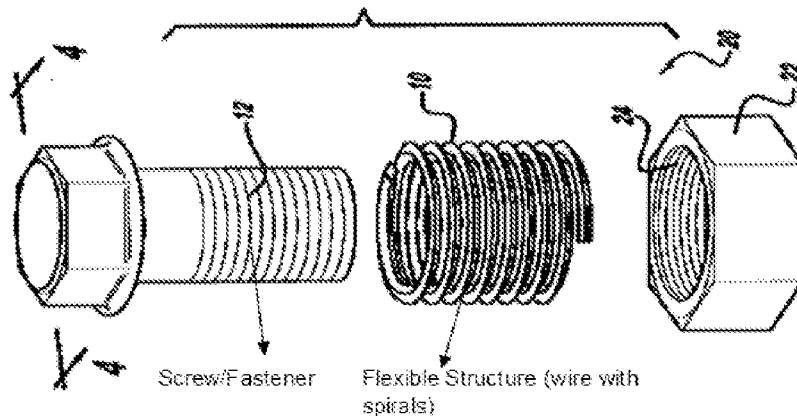
The examiner notes that Bayer does not specifically disclose the wire is made out of metal, but paragraph 115 discloses the screw is made out of steel, where it would be obvious to one having ordinary skill in the art at the time the invention was made to also have the wire be a metal, such as steel, since wires are generally made out of metal and metals such as steel are biocompatible/medical grade (see paragraph 115).

8. **Claims 5-7, 10-12** rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al US 6,267,765 and Asnis et al US 5,217,462 as applied to claims 1-4, above in further view of Giannakakos US 2003/0086772.

Taylor et al and Asnis et al disclose the claimed invention as discussed above where the extension piece has an external thread on the distal end portion but does not specifically disclose the thread is a flexible structure in the form of a metal wire wound into a spiral, where the wire has spirals that are contiguous.

However Giannakakos discloses a screw where the thread is made out of a flexible structure of a metal wire wound in a spiral with spires that are contiguous (see Fig below, as well as Figs 5-7 and paragraph 19, where the thread is made out of a metal wire which has spires).

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the thread of Taylor et al and Asnis et al to include the flexible structure of metal wire as taught by Giannakakos because it applies a known technique to a known device ready for improvement to yield predictable results of forming threads on a screw (see paragraph 3, 22) and where the flexible structure also provides excellent corrosion resistance and is lightweight (see paragraph 11).

Response to Arguments

9. Applicant's arguments with respect to claims above have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and relied upon is considered pertinent to the applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAN CHRISTOPHER MERENE whose telephone number is (571)270-5032. The examiner can normally be reached on 8 am - 6pm Mon-Thurs, alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jan Christopher Merene/

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733